

REMARKS**I. General**

Claims 1-30 are pending in the present application. Claims 1, 21, and 29 have been amended. The outstanding issues in the current Office Action are as follows:

- Claims 1-30 are rejected under 35 U.S.C. § 112, Second Paragraph, as being incomplete for omitting essential steps and indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention; and
- Claims 1-30 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,393,535 to Burton et al. (hereinafter *Burton*).

II. Claim Amendments

Claims 1, 21, and 29 have been amended to delete language from their respective preambles. Accordingly, no new matter is presented. Moreover, this amendment does not alter the scope of the claims.

III. Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 1-30 are rejected under 35 U.S.C. § 112, Second Paragraph, as being incomplete for omitting essential steps and indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Office Action at page 4. Applicant points out that independent claims 1, 21, and 29 have been amended to delete language from their respective preambles, thus rendering the 35 U.S.C. § 112 rejection with respect to claims 1-30 now moot.

IV. Rejection under 35 U.S.C. § 102 (e) ---*Burton*

The Examiner rejected claims 1-30 under 35 U.S.C. § 102(e) as being anticipated by *Burton*. Applicant respectfully traverses this rejection and asserts that the rejected claims are allowable at least for the reasons stated below.

A. Failure to teach every element of the claim

It is well settled that to anticipate a claim, the reference must teach every element of the claim. MPEP § 2131. Applicant respectfully asserts that the rejection does not satisfy this requirement.

1. Independent Claims

Claim 1 requires, in part:

comparing at least a portion of returned device identification information to at least a portion of said stored discovery information.

Claim 21 requires, in part:

means for comparing at least a portion of device identification information received in response to said query to at least a portion of said stored discovery information.

Claim 29 requires, in part, that:

at least one host agent process [be] operable to . . . compare information returned by said at least one storage device to at least a portion of discovery information stored for said at least one storage device . . .

The only passage of *Burton* relied upon by the Examiner as meeting these limitations states that:

[w]hen returning inquiry data [record 50] to a host 4a, b, the controller 14a, b would use the configuration data indicating the preferred path assignment to update the preferred path field 54 of the inquiry data [record] 50 to indicate the preferred path to the LUN.

Burton at column 5, lines 12-20. Applicant respectfully points out that the cited passage refers to *Burton*'s "discovery phase," during which a driver (22a, b) sends a inquiry data record (50) to a controller (14a, b). In response to that inquiry, the controller transmits data (e.g., LUN ID 72 and serial number 78) back to the device driver. Subsequently, the device driver inserts the data provided by the controller into a table (24a, b). *Burton* at column 5, lines 25-29 and 44-65; figure 4. Therefore, while this passage may disclose inserting entries provided by a controller into a table, it does not teach or suggest comparing returned device identification information with stored discovery information, as required by the claims.

Applicant has been unable to identify any other passages of *Burton* that may teach or suggest the aforementioned claimed limitations. Accordingly, it is respectfully submitted that independent claims 1, 21, and 29 are patentable over the 35 U.S.C. § 102 rejection of record.

2. Dependent Claims

Claims 2-20, 22-28, and 30 depend either directly or indirectly from their respective base claims 1, 21 and 29, and thereby inherit all of the limitations of their respective base claims. Accordingly, it is respectfully submitted that dependent claims 2-20, 22-28, and 30 are patentable over the 35 U.S.C. § 102 rejection based on *Burton*.

V. Summary

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10004559-1 from which the undersigned is authorized to draw.

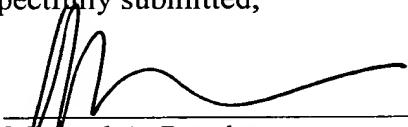
I hereby certify that this correspondence is being deposited with the United States Postal Service Express Mail Label EV568242278US in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: July 27, 2006

Typed Name: Joy H. Perigo

Signature: 

Respectfully submitted,

By: 

Michael A. Papalas
Reg. No. 40,381
Attorney/Agent for Appellant(s)

Date: July 27, 2006

Telephone No. (214) 855-8186